

Remarks/Arguments:

The pending claims are 1-18. Claim 1 has been amended. Claim 18 has been added. No new matter is introduced therein.

Claims 1-17 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Kato et al. (U.S. Patent No. 6,175,990) in view of Hayashi (U.S. Patent No. 6,530,121), Han (U.S. Patent No. 6,085,387), or Jung (U.S. Patent No. 5,697,124) and further in view of Lin (U.S. Patent No. 6,108,868).

Claim 1 recites, in part:

An opening and closing device adapted to be coupled to a moveable part of a second device, the opening and closing device comprising:

a case in substantially tubular shape.

The Office Action contends that Kato provides an opening and closing device comprising a case 15a in substantially tubular shape. Applicants respectfully disagree. In Kato, the opening and closing devices are hinge devices A and B, shown in Figure 4. (col. 5, lines 46-47). It is these hinge devices that are for opening and closing a second device, such as the portable telephone shown in Figure 4. (col. 1, lines 32-35; col. 5, lines 44-46). Although Kato does disclose that the portable telephone comprises a case (col. 5, line 44), such a disclosure does not support the Office Action's interpretation of claim 1. Claim 1 recites that the opening and closing device comprises a case. Since element 15a is not part of hinge devices A and B in Kato (the opening and closing devices), Kato element 15a does not disclose the above recitation in claim 1.

Recognizing the infirmity of its position, the Office Action acknowledges that Kato does not disclose the device being "adapted to be coupled to a moveable part of a second device," the Office Action attempts to rely upon Hayashi, Han or Jung to meet this recitation. Page 2 of the Office Action, however, states only that "each of Hayashi, Han, and Jung discloses the concept of a tubular case for attachment of a similar type hinge member as a single unit." (emphasis added). "The prior art must suggest the desirability of the claimed invention." MPEP §2143.01. In other words, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. The Office Action has not pointed to anything either in Kato or in any of Hayashi, Han or Jung suggesting that element 15a should be transformed from its present structure into the kind of case disclosed in the secondary references. Instead, the Office Action states only that the secondary references teach the "concept" of using such a case in Kato.

In addition, the references do not disclose or suggest how a case could be added to Kato's telephone parts and how such a case would be coupled each Kato's hinges A and B. The Office Action does not point to anything in Kato disclosing or suggesting how such a case could have been used in Kato. As a result, the Office Action is relying on the hindsight of applicants' disclosure in order to attempt to combine Kato with the secondary references.

Accordingly, there is no basis upon which to conclude that one of ordinary skill in the art would have combined Kato with either of Hayashi, Han, or Jung.

Claim 1 also recites, in part:

a case in substantially tubular shape including a first end face. . .;

* * * * *

a lubricant means placed between the stator and the first end face of the case.

The Office Action acknowledges that Kato does not disclose a lubricant means. On page 3, the Office Action contends that Lin "teaches the concept of lubrication means of slide members 80, located in various parts of the hinge, for the purpose of providing a reduction to friction." (emphasis added) The Office Action then contends that it would have been obvious to include such lubrication means in Kato "as generally taught by Lin, for the purpose of providing a reduction to friction during rotation." (emphasis added). Applicants respectfully disagree. Applicants incorporate the arguments they made above regarding a reference teaching only a concept and a reference that only generally teaches something.

In their Amendment filed on March 15, 2005, applicants argued that element 11 in Kato is a friction plate and that substituting a lubricating washer taught in Lin for Kato's friction plate 11 would counteract the purpose of the friction plate. This, applicants argued, would prevent Kato's device from operating as designed. In response, page 4 of the current Office Action states:

Kato does not explicitly state that the "friction" element 11 is for providing resistance to rotation, so it could well be the case, when consideration the material of construction as nylon, that this element is intended to provide a lubrication effect. But even if it were intended to provide a friction force, it has been well established in the art that combinations of lubrication elements and friction elements are common in a variety of types of hinge constructions. (emphasis added)

The Office Action's statement that "it could well be the case" that element 11 in Kato is intended to provide a lubrication effect," is pure guesswork, without any foundation whatsoever, either in Kato itself or in some other source. There is absolutely no basis for the Office Action to conclude that "friction" means exactly the opposite, lubrication. In fact, dictionary definitions demonstrate that the terms have completely different meanings. "Friction" means "the force that resists relative motion between two bodies in contact." Merriam-Webster's Collegiate Dictionary, 11th Edition. A "lubricant" is "something that lessens or prevents friction or difficulty." *Id.*

In addition, the Office Action has not pointed to anything to support its contention that "it has been well established in the art that combinations of lubrication elements and friction elements are common in a variety of hinge constructions." Because the USPTO is required to provide substantial evidence in support of its arguments, applicants request the USPTO to provide such evidence. Even if such evidence is provided, however, the USPTO is still obligated to demonstrate why it would have been obvious to substitute a lubrication means for the friction means 11 in Kato. Alternatively, the USPTO is also obligated to demonstrate why it would have been obvious to add a lubrication means at the location of the friction means 11 in Kato. Finally, the USPTO must demonstrate why using such a lubrication means in Kato would not significantly alter, or destroy, the operation of the Kato device.

Claim 1 has been amended to recite, in part:

a stator facing the first end face inside the case, the stator having a
portion extending from a stator face;

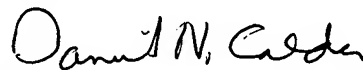
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wherein the portion of the stator extending from the stator face is
disposed through an opening in the lubricant means.

The amendment is supported, for example, by element 1A in Figure 2. Since Kato does not disclose or suggest a portion extending from a face of its stator 10, it also does not disclose such a portion disposed through an opening in a lubricant means. Newly added claim 18 further describes the portion of the stator that extends as being "fixed to the second housing." Since Kato does not have an extending portion, it also does not have an extending portion that is fixed to the second housing.

For all of the above reasons, amended claim 1, and its dependent claims 2-18 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Kato et al. in view of Hayashi, Han, or Jung and further in view of Lin.

Respectfully submitted,



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LEA/ds

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